UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,527	11/24/2003	Taro Fukaya	245820US0TTCRD	1993

22850 7590 04/05/2006

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
SERGENT, RABON A	
ART UNIT	**PAPER NUMBER**
1711	

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/718,527	FUKAYA ET AL.	
	Examiner	Art Unit	
	Rabon Sergent	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 January 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-4, 6, 7, 10, and 12-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/445,361. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set claims is drawn to compositions and methods wherein a urethane resin has been decomposed or recycled by treating the resin with a carboxyl group derived compound.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-4, 6, 7, 10, and 12-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/870,905. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set claims is drawn to compositions and methods wherein a urethane resin has been decomposed or recycled by treating the resin with a carboxyl group derived compound.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-4, 6, 7, 10, and 12-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 10/873,237. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set claims is drawn to compositions and methods wherein a urethane resin has been decomposed or recycled by treating the resin with a carboxyl group derived compound.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by WO 01/34672.

The reference discloses the treatment of polyurethane with a carboxylic acid anhydride. See page 21, lines 6+.

7. Applicants argument has been considered; however, the argument in no way distinguishes the instant claim from the prior art. Applicants' claim merely requires the addition of an anhydride to a urethane resin and this is what is disclosed by the reference. See the last three lines of the abstract.

8. Claims 5, 8, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Falke et al. ('344) or Lidy et al. ('078).

The reference discloses the production of polyols, wherein a polyurethane is decomposed in the presence of an epoxy compound. See column 4, lines 37+ within Falke et al. See abstract of Lidy et al. The references further disclose the presence of hydroxyl functional compounds that are considered to meet the requirements of claim 8. See column 5, lines 35-50 within Falke et al. See column 3, lines 30-35 within Lidy et al. Despite applicants' argument, it is not seen how applicants' amendments have overcome the rejection.

9. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Aguirre ('931).

The reference discloses the treatment of polyurethane with a carboxylic acid salt. See column 2, lines 20+ and column 3, line 46. Despite applicants' argument, it is not seen how applicants' amendments have overcome the rejection.

10. Claims 1, 2, 6, 7, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Schneider et al. ('749).

The reference discloses the decomposition of polyurethane by treatment with polyester adducts. See abstract and column 6, lines 50+. Despite applicants' argument, it is not seen how applicants' amendments have overcome the rejection.

11. Claims 5 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Wiggins et al. ('991).

The reference discloses the treatment of polyurethane with diisocyanates or epoxy compounds. See abstract. The reference further discloses the presence of hydroxyl functional compounds that are considered to satisfy the requirements of claim 8. See column 3, line 25. Despite applicants' argument, it is not seen how applicants' amendments have overcome the rejection.

12. Claims 1, 2, 6, 7, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Broeck et al. ('151).

The reference discloses the decomposition of polyurethane by treatment with polyester polyols. See examples. Despite applicants' argument, it is not seen how applicants' amendments have overcome the rejection.

13. Claims 1, 2, 6, 7, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Heiss ('577).

The reference discloses the decomposition of polyurethane by treatment with polyester polyols and/or metal carboxylate salts. See column 3, line 41 through column 4, line 12. Despite applicants' argument, it is not seen how applicants' amendments have overcome the rejection.

14. Claims 1, 2, 9, 10, 12, 15, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Heiss ('824).

The reference discloses the decomposition of polyurethane by treatment with carboxylic acids. See column 1, lines 54+ and column 2.

15. Applicants' arguments have been considered; however, the arguments are not commensurate in scope with the claims and are not representative of Heiss. Despite applicants' remarks, Heiss discloses the use of carboxylic acids, as opposed to anhydrides, to decompose the urethane. Furthermore, except for claims 2 and 10, applicants' claims are not limited with respect to quantity of acid used. With respect to claims 2 and 10, applicants have not established that the reference does not encompass the claimed quantity.

16. Claims 1-4, 9, 10, and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Yang et al. ('167).

The reference discloses the decomposition of polyurethane by treatment with carboxylic acid anhydrides. See abstract and column 3, lines 5+.

17. Applicants' arguments have been considered; however, they are not commensurate in scope with the claims. Despite applicants' remarks, the claims merely require the addition of an acid anhydride to a polyurethane, and this is what is disclosed by the reference. See column 3, lines 5+. Furthermore, applicants have in no way established that the reference does not encompass the claimed quantities of claims 2 and 10.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

RABON SERGENT
PRIMARY EXAMINER